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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Itaru Hatanaka

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

PIZIALI, JEFFREY J

ART UNIT

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2629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/955,059	Applicant(s) HATANAKA ET AL.	
	Examiner Jeff Piziali	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims:

Claims pending in the application are 19,21-25,29,31-33,38,61,64,66-70,74,76-78,83,109,111-115,121-123 and 128.

Continuation of Disposition of Claims:

Claims subject to restriction and/or election requirement are 19,21-25,29,31-33,38,61,64,66-70,74,76-78,83,109,111-115,121-123 and 128.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the figures.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83, drawn to:

a control system (claim 19),
a control system (claims 21-25 and 31),
a control system (claim 29),
a server (claims 32 and 33),
a server (claim 38),
a computer readable storage medium (claim 61),
a computer readable storage medium (claim 64),
a computer readable storage medium (claims 66-70, 74, and 76),
a storage medium (claims 77 and 78), and
a computer readable storage medium (claim 83);
classified in class 345, subclass 163 (*e.g., pointing unit products*).

II. Claims 109, 111-115, 121-123, and 128, drawn to:

a control method (claim 109),
a control method (claims 111-115 and 121),
an information processing method (claims 122 and 123), and
an information processing method (claim 128);
classified in class 715, subclass 764 (*e.g., methods of controlling displayed objects*).

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The inventions are distinct, each from the other because of the following reasons:

5. Inventions I and II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h).

(1) In the instant case, the process for using the product as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claim 19*) not including at least:

"said control system comprising: a recognizing unit recognizing an object in the motion picture on which a pointing manipulation is effected," as claimed in independent claim 19 (*lines 3-5*);

"a processing unit executing a predetermined process related to the object recognized," as claimed in independent claim 19 (*lines 6-7*);

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"wherein said processing unit, when the object is recognized from the pointing manipulation during the displaying of the motion picture contained in a first data, commands said display device to effect a first changeover to an output of a second data related to the object, and said processing unit commands said display device to execute a second changeover to display the motion picture after outputting the second data," as claimed in independent claim 19 (lines 8-12); and

"said display device includes a recording unit recording data related to the motion picture contained in the first data and said output of the second data, and said processing unit, after outputting the second data, issues a command of displaying the motion picture from a point of the first changeover recorded on said recording unit," as claimed in independent claim 19 (lines 13-16).

For example, the process as claimed (in claims 109, 111-115, 121-123, and 128) can be practiced with another materially different product (of claims 21-25 and 31) not including at least:

"said control system comprising: a communication unit transmitting the position on the motion picture receiving a pointing manipulation to a server including a unit recognizing an object in the motion picture receiving the pointing manipulation, and receiving, from said server, information on the object in the motion picture recognized by said server," as claimed in independent claim 21 (lines 3-7); and

"a processing unit executing a predetermined process related to the object recognized," as claimed in independent claim 21 (line 8).

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For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claim 29*) not including at least:

"a control system for controlling a display device including a reproducing unit reproducing a motion picture recorded on a recording medium wherein said recording medium is recorded with an image related to an object together with the motion picture, a display unit displaying the motion picture reproduced by the reproducing unit, and a pointing unit pointing a position on the motion picture, said control system comprising," as claimed in independent claim 29 (*lines 1-5*);

"a communication unit transmitting the position on the motion picture receiving a pointing manipulation to a server including a unit recognizing an object in the motion picture based on the position on the motion picture, and receiving, from said server, information on the object in the motion picture recognized by said server," as claimed in independent claim 29 (*lines 6-9*);

"a processing unit executing a predetermined process related to the object recognized," as claimed in independent claim 29 (*lines 10-11*); and

"wherein said processing unit makes said reproducing unit reproduce from said recording medium the image related to the object and makes said display device display the reproduced image," as claimed in independent claim 29 (*lines 16-18*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claims 32 and 33*) not including at least:

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"a server in linkage with a display device including a receiving unit receiving data containing a motion picture, a display unit displaying the motion picture, and a pointing unit pointing a position on the motion picture," as claimed in independent claim 32 (*lines 1-3*);

"said server comprising: a communication unit receiving information on the position where a pointing manipulation is effected from said display device," as claimed in independent claim 32 (*lines 3-5*);

"a recognizing unit recognizing an object in the motion picture receiving the pointing manipulation based on the information received from said display device," as claimed in independent claim 32 (*lines 6-7*); and

"a processing unit executing a predetermined process related to the object recognized," as claimed in independent claim 32 (*line 8*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claim 38*) not including at least:

"a server issuing a command to a data distribution system in linkage with a display device including a receiving unit receiving data containing a motion picture from the data distribution system, a display unit displaying the motion picture, and a pointing unit pointing a position on the motion picture," as claimed in independent claim 38 (*lines 1-4*);

"said server comprising: a communication unit receiving information on the position where a pointing manipulation is effected on the motion picture from said display device," as claimed in independent claim 38 (*lines 4-6*);

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"a recognizing unit recognizing an object in the motion picture receiving the pointing manipulation based on the information received from said display device," as claimed in independent claim 38 (*lines 7-8*);

"a referring unit referring to an instruction related to the object," as claimed in independent claim 38 (*line 9*); and

"a commanding unit commanding said data distribution system to change over the data containing the motion picture to be distributed in accordance with the instruction," as claimed in independent claim 38 (*lines 10-11*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claim 61*) not including at least:

"a computer readable storage medium embodying a program of instructions executable by a machine to control a display device including a display unit displaying a motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 61 (*lines 1-4*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claim 64*) not including at least:

"a computer readable storage medium embodying a program of instructions executable by a machine to control a display device including a display unit displaying a motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 64 (*lines 1-4*).

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For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claims 66-70, 74, and 76*) not including at least:

"a computer readable storage medium embodying a program of instructions executable by a machine including a communication unit to control a display device including a display unit displaying a motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 66 (*lines 1-5*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claims 77 and 78*) not including at least:

"a storage medium readable by a machine embodying a program of instructions executable by the machine including a communication unit seas-to operate in linkage with a display device including a receiving unit receiving data containing a motion picture, a display unit displaying the motion picture, and a pointing unit pointing a position on the motion picture," as claimed in independent claim 77 (*lines 1-5*).

For example, the process as claimed (*in claims 109, 111-115, 121-123, and 128*) can be practiced with another materially different product (*of claim 83*) not including at least:

"a computer readable storage medium embodying a program of instructions executable by a machine including a communication unit issuing a command to a data distribution system in linkage with a display device including a receiving unit receiving data containing a

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motion picture from said data distribution system, a display unit displaying the motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 83 (lines 1-6).

(2) In the instant case, the product as claimed (*in claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83*) can be used in a materially different process of using that product (*of claims 109, 111-115, 121-123, and 128*).

For example, the product as claimed (*in claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83*) can be used in a materially different process of using that product (*of claim 109*) without at least:

"a control method of controlling a display device including a display unit displaying a motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 109 (lines 1-3);

"said method comprising: recognizing an object in the motion picture on which a pointing manipulation is effected," as claimed in independent claim 109 (lines 3-5);

"executing a predetermined process related to the object recognized," as claimed in independent claim 109 (line 6);

"wherein said predetermined process involves, when the object is recognized from the pointing manipulation during the displaying of the motion picture contained in a first data, commanding said display device to effect a first changeover to an output of a second data related to the object," as claimed in independent claim 109 (lines 7-10);

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"said predetermined process involves commanding said display device to execute a second changeover to displaying the motion picture after outputting the second data," as claimed in independent claim 109 (lines 11-13); and

"said display device further includes a recording unit recording data related to the motion picture contained in the first data and said output of the second data, and said predetermined process involves issuing a command of displaying the motion picture from a point of the first change over recorded on said recording unit after outputting the second data," as claimed in independent claim 109 (lines 14-17).

For example, the product as claimed (*in claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83*) can be used in a materially different process of using that product (*of claims 111-115 and 121*) without at least:

"a control method of controlling a display device including a display unit displaying a motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 111 (lines 1-3);

"said method comprising: transmitting the position on the motion picture receiving a pointing manipulation to a server including a recognizing unit recognizing an object in the motion picture receiving the pointing manipulation," as claimed in independent claim 111 (lines 3-6);

"receiving, from said server, information on the object in the motion picture recognized by said server," as claimed in independent claim 111 (lines 7-8); and

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"executing a predetermined process related to the object recognized," as claimed in independent claim 111 (*line 9*).

For example, the product as claimed (*in claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83*) can be used in a materially different process of using that product (*of claims 122 and 123*) without at least:

"an information processing method for a computer including a communication unit to operate in linkage with a display device including a receiving unit receiving data containing a motion picture, a display unit displaying the motion picture, and a pointing unit pointing a position on the motion picture," as claimed in independent claim 122 (*lines 1-4*);

"said method comprising: receiving information on the position where a pointing manipulation is effected from said display device," as claimed in independent claim 122 (*lines 4-6*);

"recognizing an object in the motion picture receiving the pointing manipulation based on the information received from said display device," as claimed in independent claim 122 (*lines 7-8*); and

"executing a predetermined process related to the object recognized," as claimed in independent claim 122 (*line 9*).

For example, the product as claimed (*in claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, and 83*) can be used in a materially different process of using that product (*of claim 128*) without at least:

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"an information processing method for a computer including a communication unit to issue a command to a data distribution system in linkage with a display device including a receiving unit receiving data containing a motion picture from said data distribution system, a display unit displaying the motion picture and a pointing unit pointing a position on the motion picture," as claimed in independent claim 128 (*lines 1-5*);

"said method comprising: receiving information on the position where a pointing manipulation is effected on the motion picture," as claimed in independent claim 128 (*lines 5-7*);

"recognizing an object in the motion picture receiving the pointing manipulation based on the information received from said display device," as claimed in independent claim 128 (*lines 8-9*);

"referring to an instruction related to the object," as claimed in independent claim 128 (*line 10*); and

"commanding said data distribution system to change over the data containing the motion picture to be distributed in accordance with the instruction," as claimed in independent claim 128 (*lines 11-12*).

6. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

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- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so**

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may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/
Primary Examiner, Art Unit 2629
30 December 2008